



UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

MU

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/345,373 07/01/99 RUBEN

S 1448.036000A

HM12/0501
STERNE KESSLER GOLDSTEIN & FOX PLLC
1100 NEW YORK AVENUE NW
SUITE 600
WASHINGTON DC 20005-3934

EXAMINER

SAOUD, C

ART UNIT	PAPER NUMBER
----------	--------------

1647

DATE MAILED:

05/01/01

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

1- File Copy

Office Action Summary

Application No.

09/345,373

Applicant(s)

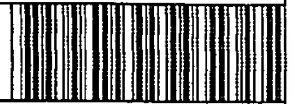
RUBEN et al.

Examiner

Christine Saoud

Art Unit

1647



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 16, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43-45 and 94-182 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 43-45 and 94-182 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

Restriction Requirement:

Applicants election of Invention I, now represented by claims 95-182 in paper number 7 filed 2/8/01, without traverse, is acknowledged.

Applicants newly filed claims are drawn to numerous patentably distinct polypeptides with distinct amino acid sequences. It is noted that some of these embodiments were present in the original claims, however, through an inadvertent error, this following restriction requirement was omitted. Thus, further restriction *within* the formerly presented Invention I is required, as follows:

The claims are drawn to numerous patentably distinct polypeptides, each of which constitutes a patentably distinct product. Applicant is required to elect a single invention of a polypeptide, selected from the group consisting of:(i.e. elect one from the following Markush group):a polypeptide comprising an amino acid sequence of residues 41-71 of SEQ ID NO:2, 91-109 of SEQ ID NO:2, 135-164 of SEQ ID NO:2, 181-199 of SEQ ID NO:2, 1-141 of SEQ ID NO:96, 138-208 of SEQ ID NO:2, 123-208 of SEQ ID NO:2, 104-208 of SEQ ID NO:2, 77-208 of SEQ ID NO:2, 69-208 of SEQ ID NO:2, 63-208 of SEQ ID NO:2, 37-208 of SEQ ID NO:2, 36-208 of SEQ ID NO:2, 2-208 of SEQ ID NO:2, 63-153 of SEQ ID NO:2, 36-153 of SEQ ID NO:2.

To be fully responsive to this requirement, Applicants are **required** to point out which claims correspond to the elected invention.

Although the classifications for these various polypeptides are overlapping, for instance 530/350, each represents a patentably distinct product with distinct physical and functional

characteristics. Further the search for more than one product would be burdensome, because each polypeptide requires a search of the corresponding region of SEQ ID NO: 2 which requires a separate "word search" of the polypeptide databases, or by claiming polypeptides which have percent identity to a disclosed polypeptide, which requires a broader search of the polypeptide databases. Accordingly, restriction is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(i).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine J. Saoud, Ph.D., whose telephone number is (703) 305-7519. The examiner can normally be reached on Monday to Friday from 7AM to 3PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623.

Certain papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1 (CM1). The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by Applicant or Applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers.

Application/Control Number: 09/345,373
Art Unit: 1647

Page 4

Official papers filed by fax should be directed to (703) 308-4556. If this number is out of service, please call the Group receptionist for an alternate number. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294. Official papers should NOT be faxed to 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

April 30, 2001

**CHRISTINE J. SAOUD
PRIMARY EXAMINER**

Christine J. Saoud